

### REMARKS

The Office action of August 11, 2004, has been carefully considered.

Claims 14 through 30 have been rejected under 35 USC 101 on the basis that the claimed invention is directed to non-statutory subject matter.

In response to this rejection, Applicant has amended the claims to indicate that certain steps are performed by a computer. In particular, data received from an investor is entered into a computer, calculations are made by the computer, and an output from the computer is presented to the investor to indicate a range of investment choices. The data entered from the investor relates to the market value of an asset, which is an amount that can be easily determined, and the preferred amount for investment and the preferred term of the investment, which are quantities that are defined by the investor. The output is presented to the investor in the form of tables such as those shown in Tables 4, 5 and 6a through 6e of the present application, based upon calculations which were recently made by the computer. Thus, the result is not speculative, but is based upon known calculations made to known quantities, known because they are defined by the personal preferences of the individual being served by the method.

Withdrawal of this rejection is accordingly requested.

Claims 14 through 30 have been rejected under 35 USC 112, first paragraph, for the reasons defined above, and applicant submits that this rejection should also be withdrawn for the reasons set forth with regard to the previous rejection.

Claims 14 through 30 have been rejected under 35 USC 112, second paragraph, on the basis that the terminology used renders the claims indefinite. With regard to the terminology

set forth, it is noted that the term "potential" has been deleted, and replaced in instances by "expected," since this is a term relating to a quantity that can be easily determined. Moreover, the term "preferred" relates to the preferences of the investor, and is not at all indefinite. The remaining terminology is terminology defined in the specification and well known in the art of investment planning, and the meaning of these terms is easily determined by those of ordinary skill in the art.

Withdrawal of this rejection is requested.

Claims 14 through 30 have been rejected under 35 USC 102(b) over Roberts et al.

Applicant submits that the comparisons made in the Office Action between the Roberts et al patent and the steps of the claimed invention are now well grounded.

The claimed invention relates to a method for selecting an amount to be invested in a futures contract in which a prudent amount is estimated in relation to the value of an existing asset which the investor wishes to preserve should the outcome of the contract be unfavorable. The method is implemented by a series of computer steps as described in the specification.

In contrast, the Roberts et al patent relates to a method of obtaining insurance to cover a future cost in the event of an unfavorable circumstance, specifically the cost for a college education for a student in the event that a parent dies or is otherwise unable to meet those costs. There is no suggestion of preserving an existing asset, as defined in the present claims.

For example, Claim 14 requires calculating market values for a range of futures investments using the discount value of the asset and the preferred term of the investment, and

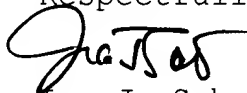
presenting the investor with a range of market values for the range of investments. Neither of these steps can be found in Roberts et al, and the reference to "6A-6B; 7A-7B" and Claim 1 in Roberts et al appear to be without foundation.

Indeed, Claim 1 of Roberts et al does not include the steps of presenting the investor with a range of investments and receiving from the investor an indication of the investment. Quite to the contrary, the investment selection appears to be done without input from the investor, for example as set forth at column 26, lines 47 through 58, and the investor need only pay premiums to support the entire system.

Accordingly, the Roberts et al patent does not have the same object as that of the claimed invention, and does not include the same series of steps as the claimed invention. Withdrawal of this rejection is requested.

In view of the foregoing amendments and remarks, Applicant submits that the present application is now in condition for allowance. An early allowance of the application with amended claims is earnestly solicited.

Respectfully submitted,



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